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HEWLETT-PACKARD COMPANY  
Intellectual Property Administration  
P.O. Box 272400  
Fort Collins, Colorado 80527-2400

PATENT APPLICATION

ATTORNEY DOCKET NO. 10012443-1IN THE  
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Travis J. Parry

Confirmation No.: 4430

Application No.: 09/925,849

Examiner: Mark E. Wallerson

Filing Date: Aug. 10, 2001

Group Art Unit: 2626

Title: Direct Printing From Internet Database

Mail Stop Appeal Brief-Patents  
Commissioner For Patents  
PO Box 1450  
Alexandria, VA 22313-1450TRANSMITTAL OF APPEAL BRIEFTransmitted herewith is the Appeal Brief in this application with respect to the Notice of Appeal filed on Sep. 30, 2005.

The fee for filing this Appeal Brief is (37 CFR 1.17(c)) \$500.00.

(complete (a) or (b) as applicable)

The proceedings herein are for a patent application and the provisions of 37 CFR 1.136(a) apply.

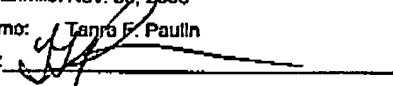
☐ (a) Applicant petitions for an extension of time under 37 CFR 1.136 (fees: 37 CFR 1.17(a)-(d)) for the total number of months checked below:☐ 1st Month  
\$120☐ 2nd Month  
\$450☐ 3rd Month  
\$1020☐ 4th Month  
\$1590☐ The extension fee has already been filed in this application.☒ (b) Applicant believes that no extension of time is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.Please charge to Deposit Account 08-2025 the sum of \$ 500. At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 08-2025 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 08-2025 under 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees. A duplicate copy of this sheet is enclosed.☐ I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to:  
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Rev 10/05 (Ap/Brief)

Respectfully submitted,

Travis J. Parry

By 

Jack H. McKinney

Attorney/Agent for Applicant(s)

Reg No.: 45,685

Date: Nov. 30, 2005

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Date of Deposit: November 30, 2005

Typed or printed name: Tanra F. Paulin

Signature: \_\_\_\_\_

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DOCKET NO. 10012443-1

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UNITED STATES PATENT AND TRADEMARK OFFICE

INVENTOR(S): Travis J. Parry

SERIAL NO.: 09/925,649

GROUP ART UNIT: 2626

FILED: August 10, 2001

EXAMINER: Wallerson, Mark E

SUBJECT: Direct Printing from Internet Database

APPELLANTS'/APPLICANTS' OPENING BRIEF ON APPEAL

1. REAL PARTY IN INTEREST.

The real party in interest is Hewlett-Packard Development Company, LP, a limited partnership established under the laws of the State of Texas and having a principal place of business at 20555 S.H. 249 Houston, TX 77070, U.S.A. (hereinafter "HPDC"). HPDC is a Texas limited partnership and is a wholly-owned affiliate of Hewlett-Packard Company, a Delaware Corporation, headquartered in Palo Alto, CA. The general or managing partner of HPDC is HPQ Holding, LLC.

09/925,649  
Docket No. 10012443-1  
Appellants' Opening Brief  
Page 1

**2. RELATED APPEALS AND INTERFERENCES.**

There are no other appeals or interferences known to Appellants, Appellants' legal representative or the Assignee which will affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**3. STATUS OF CLAIMS.**

Claims 1-19 pending, but stand rejected. All pending claims are appealed.

**4. STATUS OF AMENDMENTS.**

Following the final rejection, Claim 19 was amended so that its preamble recites a computer readable medium that has machine readable program code. In the subsequent Advisory Action, the Examiner did not indicate whether or not that amendment was entered. All other amendments have been entered.

**5. SUMMARY OF CLAIMED SUBJECT MATTER.**

Claim 1 recites a printing method in which print stream data is received at a printer. See Specification, para. [0029]. At the printer, a network address in the received print stream data is detected. See Specification, para. [0029]. Assuming a network address is detected, a message from the printer is displayed or sent to notify a user entity of the network address detection and to request authorization from the user entity to access the network address. See Specification, para. [0034]. If authorization to access is received from the user entity at the printer, an access request for the document is sent to the network address from the printer. See Specification, para. [0038]. The document is retrieved from the network address at the printer. See Specification, para. [0040]. At the printer, the document from the network address is merged into the print stream data to form a modified document. See Specification, para. [0041]. The modified document is then printed. See Specification, para. [0041].

Claim 19 recites a program product comprising a computer readable medium having machine readable program code for implementing the method of Claim 1.

**6. GROUNDS FOR REJECTION TO BE REVIEWED.**

09/925,649  
Docket No. 10012443-1  
Appellants' Opening Brief  
Page 2

Neither Tabata nor Russell, individually or combined, teaches, at a printer, merging a document into print stream data received at the printer to form a modified document where the document being merged into the print stream data is obtained at the printer from a network address detected in the print stream data.

#### **7. ARGUMENT.**

**Claims 1-19 – Neither Tabata nor Russell, individually or combined, teaches, at a printer, merging a document into print stream data received at the printer to form a modified document where the document being merged into the print stream data is obtained at the printer from a network address detected in the print stream data.**

Claims 1-10, 13, 14, 18, and 19 have been rejected as being unpatentable over USPN 6,537,324 issued to Tabata in view of USPN 6,375,078 issued to Russell.

Tabata discloses a system for utilizing printed physical documents as if they were web pages displayed on a computer screen. Tabata labels this concept PUI or Paper User interaction. See, e.g., Tabata, col. 7, line 56 through col. 8, line 14. Such a printed document is referred to as medium form (201) where medium form information is the printed information on the medium form (201). See Tabata, col. 8, lines 31-58 (describing medium form information), and Tabata, col. 5, lines 47-57 (describing medium form information), and Fig. 2, reproduced below.



through col. 7, line 4; step 1202 of Fig. 12. The portion of the raster image containing the code section (206) can then be decoded to obtain linkage information for a dicon corresponding to the revealed mark. See Tabata, col. 6, line 65 through col. 7, line 4; step 1202 of Fig. 12. Using that linkage information, a correlated information file linked to that dicon can be retrieved and printed. See Tabata, steps 1207-1211 of Fig. 12. Where that correlated information file is a hypertext document, a file server (440) converts that hypertext document to medium form information to be sent to a printer to print another medium form (201). See Tabata, col. 15, lines 33-44; step 1210 of Fig. 12; col. 29, lines 1-6; and step 2105 of Fig. 21.

**Claim 1** is directed to a printing method and recites the following acts:

1. receiving print stream data at a printer;
2. detecting, at the printer, a network address in the received print stream data;
3. if a network address is detected, then displaying or sending a message from the printer notifying a user entity of the network address detection and requesting authorization from the user entity to access the network address;
4. if authorization to access is received from the user entity at the printer, sending on the Internet or other network, an access request for a document to the network address from the Printer;
5. retrieving the document from the network address at the printer;
6. merging, at the printer, the document from the network address into the print stream data to form a modified document; and
7. printing the modified document.

Neither Tabata nor Russell, individually or combined, teaches, at a printer, merging a document into print stream data received at the printer to form a modified document where the document being merged into the print stream data is obtained at the printer from a network address detected in the print stream data in the manner recited by Claim 1. The Examiner asserts that Tabata teaches all but the third and fourth acts listed above. Specifically, the Examiner states: "Tabata differs from claims 1, 6, and 19

in that he does not clearly disclose requesting from the printer (copier 470) authorization from a user entity to access the network address." For only these portions of Claim 1, did the Examiner rely on Russell.

The Examiner mistakenly asserts that Tabata teaches merging, at the printer, the document from the network address into the print stream data to form a modified document, citing Tabata col. 30, line 46 through col. 31, line 19 and col. 24, lines 24-49. The cited passages from Tabata are reproduced as follows:

The document information management system according to the present invention comprises a file unit with information relating to particular words, sentences, symbols, or graphics previously stored therein as a correlated information file; a medium form with at least one described information comprising any of words, sentences, symbols, and graphics, linkage information for linking the described information to the correlated information file in the file unit, and selection information for selecting particular described information among the described information recorded thereon; a correlated information identifying unit for reading image data from the medium form, identifying the selected correlated information file according to the selection information as well as linkage information in the read image data, and outputting an address of an appropriate correlated information file; a correlated information file retrieving unit for receiving an address of the correlated information file from the correlated information identifying unit and retrieving an appropriate correlated information file from the file unit according to the address of the correlated information file; an image data reader for reading image data from the medium form; a correlated information file identifying/retrieving unit for receiving image data from the image data reader, identifying an address of the selected correlated information file according to the selection information and linkage information in the image data, and retrieving the appropriate correlated information file from the file unit; and an output unit for outputting the correlated information file retrieved by the correlated information file retrieving unit or the correlated information file identifying/retrieving unit, so that continuity and correlation of information between a digital world such as a computer system and a paper document can be constructed, a paper document can be incorporated in the document information management system in the digital world, direct access to the digital world can be achieved by using the paper document as a medium, and further a hypertext using the paper document (paper hypertext) can be realized.

Tabata, col. 30, line 46 through col. 31, line 19.

09/925,649  
Docket No. 10012443-1  
Appellants' Opening Brief  
Page 6



The file server transfers the retrieved correlated information file to a printer 460 or to a printer 470B (S2104). However, when the correlated information file itself is found also a hypertext, as it is required to output the correlated information file as medium form information, the file server 440 prepares medium form information from the hypertext and transfers the medium form information to the printer 460 or 470B (S2105). Specification of the printer 460 or 470B as an address for transferring at that time can easily be realized by describing it on the medium form 420 or by selecting it on the medium form 420 although detailed description is omitted herein.

The printer 460 or 470B outputs the received correlated information file (including the medium form information) on recording paper as a correlated information file 450 (S2106).

As described above, with the document information management system according to Embodiment 4, continuity and correlation of information from a hypertext as a document in the digital world such as a computer system to a medium form 420 as a paper document are constructed through the linkage information on the medium form 420, so that a paper document can be incorporated in the document information management system in the digital world, direct access to the digital world can be achieved by using the paper document as a medium, and further a hypertext using the paper document (paper hypertext) can be realized.

Tabata, col. 24, lines 24-49 (emphasis added).

Following the citation of these two passages, the Examiner mischaracterizes Claim 1 by adding the following parenthetical: "(the correlated information file is incorporated with the medium form information to form a single document)". As clarified below, this is simply irrelevant to the limitations of Claim 1.

Tabata discloses assembling medium form information which is then used to print a medium form. Medium form information is assembled from a hypertext document. That hypertext document may have been retrieved following a scan of a medium form having a marked icon linked via an URL or other address to that hypertext document. That address is not detected at a printer and is not detected within print stream data in the manner required by Claim 1.

Medium form information includes, information regarding the visual appearance of the hypertext document (image extraction information), icons (described information), and linkage information. See, e.g., Tabata, col. 5, lines 28-36 (discussing preparing medium form information from a hypertext document). Medium form information is prepared at a printer server 30 or file server 440 which in turn transfers

09/25,649  
Docket No. 10012443-1  
Appellants' Opening Brief  
Page 7

the medium form information to a printer. Tabata, col. 5, lines 28-36 (printer server 30) and col. 29, lines 1-6 (file server 440). Tabata mentions:

Although a printer server is used herein as a medium form information preparing unit, it is not particularly restricted thereto, and it is needless to say that any device such as a personal computer/work station enabling execution of the medium form information preparing software may be employed. Also, a function as a medium form information preparing unit may be given to the file server 20 in place of discretely providing the printer server 30 as a medium form information preparing unit.

Tabata, col. 6, lines 38-46. Tabata makes no mention or suggestion medium form information could be assembled at a printer.

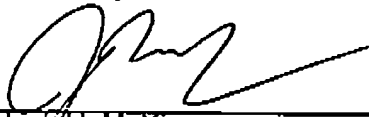
Even if Tabata's medium form information is considered to be print stream data, it only becomes so after being sent to a printer – that is – only after it is sent from a printer server (30) or a file server (440) to the printer. After Tabata's medium form information is sent to a printer, an address is not detected within that media form information and the medium form information is not merged with anything, let alone a document retrieved from a detected address.

For at least these reasons Claim 1 is patentable over Tabata and Russell, as are Claims 2-18 which depend from Claim 1.

Claim 19 is directed to a program product comprising a computer readable medium having machine readable program code for implementing the method of Claim 1. For at least the same reasons Claim 1 is patentable, so is Claim 19.

Respectfully submitted,  
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09/25,649  
Docket No. 10012443-1  
Appellants' Opening Brief  
Page 8

**APPENDIX OF CLAIMS INVOLVED IN THE APPEAL**

1 (previously presented) A printing method, comprising:  
receiving print stream data at a printer;  
detecting, at the printer, a network address in the received print stream data;  
if a network address is detected, then displaying or sending a message from the printer notifying a user entity of the network address detection and requesting authorization from the user entity to access the network address;  
if authorization to access is received from the user entity at the printer, sending on the Internet or other network, an access request for a document to the network address from the Printer;  
retrieving the document from the network address at the printer;  
merging, at the printer, the document from the network address into the print stream data to form a modified document; and  
printing the modified document.

2 (Original) The method as defined in claim 1, wherein the network address is a URL.

3 (Original) The method as defined in claim 1, wherein the detecting a network address step comprises detecting a barcode in the received data and translating the barcode to the network address.

4 (Original) The method as defined in claim 1, wherein, if no authorization to access is received, then printing the untranslated barcode.

5 (Original) The method as defined in claim 1, wherein, if no authorization to access is received, then printing the network address.

6 (Original) The method as defined in claim 1, wherein the authorization includes a username or password.

7 (Original) The method as defined in claim 1, further comprising the step of automatically sending an authorization/unauthorization for the network access based on a criteria.

8 (Original) The method as defined in claim 7, wherein the criteria is whether the network address is among one or more authorized network addresses.

9 (Original) The method as defined in claim 7, wherein the criteria is whether the printer includes antivirus capability.

10 (Original) The method as defined in claim 7, wherein the criteria is whether the network address is a secure site.

11 (Original) The method as defined in claim 1, wherein said receiving data step comprises receiving an e-mail containing said data.

12 (Original) The method as defined in claim 1, wherein said receiving data step comprises receiving an e-mail with an attachment containing said data.

13 (Original) The method as defined in claim 3, wherein said translating step comprises translating the barcode to obtain a PIN#, and wherein said sending step includes sending the PIN# with the access request to the network address for determining if the request is authorized.

14 (Original) The method as defined in claim 3, wherein the detecting a barcode step comprises interpreting a wrapper indicating that wrapped data is a barcode.

15 (Previously presented) The method as defined in claim 3, wherein the translated barcode includes information on printing the document inside another document; and further comprising the step of printing the document inside the other document in accordance with the printing information upon receipt of the document at the printer.

16 (Previously presented) The method as defined in claim 1, further comprising the step of printing the document inside in a master document.

17 (Previously presented) The method as defined in claim 3, wherein the translation step comprises:

translating the barcode to obtain at least one identifier that designates the type of contents in said document; and

determining a location of the document within the master document based on said identifier.

18. (Original) The method as defined in claim 1, wherein the displaying step comprises providing web content to a user location to display a menu of authorization selections.

19. (Previously presented) A program product comprising a computer readable medium having machine readable program code for performing the following method steps:

receiving print stream data at a printer;

detecting, at the printer, a network address in the received print stream data;

if a network address is detected, then displaying or sending a message from the printer notifying a user entity of the network address detection and requesting authorization from the user entity to access the network address;

If authorization to access is received from the user entity, sending on the Internet or other network an access request for a document to the network address from the printer;

retrieving the document from the network address at the printer;

merging, at the printer, the document from the network address into the print stream data to form a modified document; and

printing the modified document.

**Evidence Appendix**

There is no extrinsic evidence to be considered in this Appeal. Therefore, no evidence is presented in this Appendix.

**Related Proceedings Appendix**

There are no related proceedings to be considered in this Appeal. Therefore, no such proceedings are identified in this Appendix.